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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,872	11/15/2000	Ralph W. Wright JR.	A148 1596	9345

7590

06/26/2002

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EXAMINER
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NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/712,872	Applicant(s) WRIGHT ET AL.	
	Examiner Kimberly T. Nguyen	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 29-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: .  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 5, 8, 16-17, 19-22, 25, and 28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 5 and 16, it is unclear how the substrate "includes a printed pattern" because it is not clear if the pattern is located within the substrate or on top of the substrate as in Figure 1.

In claims 6, 8, 17, 19, 25, and 28 it is unclear what is meant by the phrase "in register with" and *how* the layers are in register with each other.

Claims 17 and 20-22 recite the limitation "the pigmented topcoat." There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrhart et al., U.S. Pat. No. 5,543,232 in view of Shalov et al., U.S. Pat. No. 5,830,937.

Ehrhart shows a floor covering comprising a substrate and a UV radiation cured acrylated polyester wear layer (topcoat) having a stain resistance of 26-82 Delta E units and a gloss

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retention of 87-93% (Abstract and column 9, line 29 to column 10, line 6). Ehrhart shows that the substrate comprises a laminated film (column 9, lines 18-19). Ehrhart does not show that the wear layer is pigmented as in instant claim 1. Shalov shows that a wear layer in a surface covering can be pigmented (column 16, lines 7-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a pigmented wear layer (top coat) since it known, as shown by Shalov that such layers can be colored for aesthetic purposes.

**Claims 5-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232.

Shalov shows a surface covering comprising a chemically or mechanically embossed substrate 11 (column 19, lines 1-7) and a radiation cured pigmented topcoat 20 which has high gloss values and excellent resistance to stains (Abstract and column 22, lines 31-34). Shalov shows that the surface covering further comprises a printed pattern 18 in which the pigmented topcoat 20 is in register with by indenting with the printed pattern (Figure 2). Shalov shows that the topcoat 20 is in register with the embossed texture of the substrate by indenting with the substrate (Figure 2). Shalov shows in Figure 2 that the embossed substrate has raised surfaces and indentations and that the pigmented topcoat 20 is disposed on the raises surfaces and in the indentations.

Shalov does not show that the stain resistance is about less than 150 Delta E units as in instant claim 1 nor that the topcoat has a gloss retention of at least about 80% as in instant claim 2. Ehrhart shows a floor covering comprising a substrate and a UV radiation cured acrylated polyester wear layer (topcoat) having a stain resistance of 26-82 Delta E units and a gloss retention of 87-93% (Abstract and column 9, line 29 to column 10, line 6). It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to make the surface covering of Shalov with the stain resistance of less than about 150 Delta E units since it is known, as shown by Ehrhart, that radiation curable topcoat layers with such a stain resistance is desirable in floor coverings to prevent household stains from becoming permanent in the floor covering.

**Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 and in further view of Sawka et al., U.S. Pat. No. 5,405,675.

Shalov and Ehrhart are relied upon as above for claim 1.

Shalov does not show the nacreous pigments as in instant claim 11. Sawka shows that pearlescent dyes (nacreous pigment) can be used in color layers of an embossed multilayered film (column 8, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use nacreous pigments in the pigmented topcoat of Shalov since it is known, as shown by Sawka, that various pigments such as nacreous pigments can be used to achieve a pearlescent color in the surface covering.

**Claims 12-21 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232.

Shalov shows a surface covering comprising a chemically or mechanically embossed laminate substrate 11 (column 19, lines 1-20), a UV light radiation cured pigmented intermediate wear layer 19, and a UV light radiation cured topcoat 20 which has high gloss values and excellent resistance to stains (Abstract and column 22, lines 31-34). Shalov shows that the topcoat 20 and wearlayer 19 comprise polyester acrylates (column 10, lines 37-67). Shalov

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shows that the surface covering further comprises a printed pattern 18 in which the pigmented topcoat 20 and intermediate wear layer 19 are in register with by indenting with the printed pattern (Figure 2). Shalov shows that the topcoat 20 and intermediate wear layer 19 are in register with the embossed texture of the substrate by indenting with the substrate (Figure 2). Shalov shows in Figure 2 that the embossed substrate has raised surfaces and indentations and that the pigmented topcoat 20 and intermediate wear layer are disposed on the raises surfaces and in the indentations.

Shalov does not show that the stain resistance is about less than 150 Delta E units as in instant claim 12 nor that the topcoat has a gloss retention of at least about 80% as in instant claim 12. Ehrhart shows a floor covering comprising a substrate and a UV radiation cured acrylated polyester wear layer (topcoat) having a stain resistance of 26-82 Delta E units and a gloss retention of 87-93% (Abstract and column 9, line 29 to column 10, line 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the surface covering of Shalov with the stain resistance of less than about 150 Delta E units since it is known, as shown by Ehrhart, that radiation curable topcoat layers with such a stain resistance is desirable in floor coverings to prevent household stains from becoming permanent in the floor covering.

**Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 and in further view of Sawka et al., U.S. Pat. No. 5,405,675.

Shalov and Ehrhart are relied upon as above for claims 12 and 18.

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Shalov does not show the nacreous pigments as in instant claim 22. Sawka shows that pearlescent dyes (nacreous pigment) can be used in color layers of an embossed multilayered film (column 8, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use nacreous pigments in the pigmented topcoat of Shalov since it is known, as shown by Sawka, that various pigments such as nacreous pigments can be used to achieve a pearlescent color in the surface covering.

**Claims 24-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ehrhart et al., U.S. Pat. No. 5,543,232 in view of Shalov et al., U.S. Pat. No. 5,830,937 and in further view of Hallman et al., U.S. Pat. No. 5,800,904.

Ehrhart is relied upon as above for claims 1 and 23. Shalov is relied upon for claim 1. Ehrhart does not show a printed pattern disposed on the substrate opposite the wear layer (topcoat) as in instant claim 24. Ehrhart does not show that the wearlayer (topcoat) is in register with the printed pattern as in instant claim 25.

Hallman shows a surface covering comprising a pigmented topcoat 1, a substrate film 2, and decorative print layers 4 and 5 (Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a printed pattern to the film opposite the topcoat of Ehrhart since it is known, as shown by Hallman, that decorative print layers can be located beneath the substrate film to achieve an aesthetic effect in the floor covering. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the floor covering with the topcoat being in register with the printed pattern so that decorative effects are accomplished.

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**Claims 27-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shalov et al., U.S. Pat. No. 5,830,937 in view of Ehrhart et al., U.S. Pat. No. 5,543,232 and in further view of Hallman et al., U.S. Pat. No. 5,800,904.

Shalov is relied upon as above for claims 12 and 26. Ehrhart is relied upon as above for claim 12. Shalov does not show a printed pattern disposed on the film opposite the wear layer as in instant claim 27. Shalov does not show that the wear layer is in register with the printed pattern as in instant claim 28.

Hallman shows a surface covering comprising a pigmented topcoat 1, a substrate film 2, and decorative print layers 4 and 5 (Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a printed pattern to the film opposite the topcoat of Ehrhart since it is known, as show by Hallman, that decorative print layers can be located beneath the substrate film to achieve an aesthetic effect in the floor covering. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the floor covering with the topcoat being in register with the printed pattern so that decorative effects are accomplished.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the



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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen  
Examiner  
June 20, 2002

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read 'Cynthia H. Kelly', is written over the typed name and title.